

Remarks

The Rejection under 35 U.S.C. 102(b) - Yoshihara et al.

Claims 1-12, 21-32, 41, 47, 49, 53-60 and 62-69 have been rejected under 35 U.S.C. 102(b) as being anticipated by Yoshihara et al. Applicants respectfully traverse this rejection. Yoshihara et al. do not teach the specific combination of a volatile liquid, a humectant and a skin active agent, as claimed by Applicants. All three of these substances are optional ingredients in Yoshihara et al.'s invention. There is no specific teaching to combine these compositions in the amounts claimed by Applicants. Certainly, the disclosure regarding humectants in Col. 6, lines 36-46 of Yoshihara et al. does not serve to anticipate the claimed invention. A few humectants are included in a long list of optional ingredients. There is no express teaching to combine one of the humectants with a volatile liquid and a skin active agent. Therefore, Applicants respectfully contend that the Yoshihara reference does not anticipate the claimed invention.

The Rejection under 35 U.S.C. 102(b) - Kashibuchi et al.

Claims 13, 19, 20, 33, 39, 40 and 50 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kashibuchi et al. Applicants respectfully traverse this rejection. Kashibuchi et al. do not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants.

Kashibuchi et al. is directed toward scalp moisturizers containing a combination of a glycoside, a glycolipid and a hormone. Kashibuchi et al. do not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants. In fact, Kashibuchi et al. teach away from using significant amounts of humectant. In Col. 1, line 66 to Col. 2, line 8, Kashibuchi et al. state that large amounts of humectants have the result that "an unpleasant, e.g., greasy or slimy, sense of touch is produced." There is no discussion in Kashibuchi et al. regarding the combination of a volatile liquid and a humectant. Such a combination is required by Applicants' claims. Therefore, the Kashibuchi reference does not anticipate the claimed invention.

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al.

Claims 1-12, 15-18, 21-32, 35-38, 47, 49, 51, 52, 53-60, 61 and 62-69 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. Applicants respectfully traverse this rejection. The presumption of obviousness is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

Applicants have demonstrated unexpected results regarding the combination of a volatile liquid and a humectant for applying a skin active agent. Prior art scalp tonics, such as Yoshihara et al., have used volatile carriers to apply skin actives. Volatile carriers will dissipate quickly and provide a cool feeling to the scalp. However, they also tend to dry out the skin, especially after repeated use. They can also have a negative impact on hair cosmetics. Applicants have found that a humectant can be used in combination with a volatile liquid to provide an unexpectedly high degree of moisturization in a high drying environment.

The Declaration of Marjorie Peffly, submitted herewith, evidences these unexpected results. Various formulations were evaluated for their skin surface hydration values after 4 hours. The comparison of Example A to Example F shows the surprising benefit that a humectant (glycerine, in this case) can have on skin hydration. Each of these examples had a high level of ethanol (55%). The only difference between the formulations of Example A and Example F is the addition of 5% glycerine to the Example A formulation. The results show a dramatic improvement in skin hydration. Example F had a negative effect on skin hydration (-20.03) while Example A had a strong positive effect (207.75).

Applicants submit that their claimed combination of a volatile liquid, a humectant and a skin active agent is unobvious. There is no suggestion in the Yoshihara reference that the addition of a humectant would have the significant positive effect shown in the Declaration. Yoshihara et al. include some humectants in a long list of optional ingredients. However, there is no indication that the humectants would provide added benefits to the Yoshihara scalp treatment. Certainly, Yoshihara et al. do not suggest the surprising improvement in skin hydration demonstrated by Applicants. Therefore,

Applicants contend that their claimed invention is novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Kashibuchi et al.

Claims 13, 19, 20, 33, 39, 40 and 50 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kashibuchi et al. Applicants respectfully traverse this rejection. Kashibuchi et al. does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

The Kashibuchi et al. reference does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Kashibuchi et al. do not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants.

Kashibuchi et al. is directed toward scalp moisturizers containing a combination of a glycoside, a glycolipid and a hormone. Kashibuchi does not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants. In fact, Kashibuchi et al. teach away from using significant amounts of humectant. In Col. 1, line 66 to Col. 2, line 8, Kashibuchi et al. state that large amounts of humectants have the result that "an unpleasant, e.g., greasy or slimy, sense of touch is produced." There is no discussion in Kashibuchi et al. regarding the combination of a volatile liquid and a humectant. Such a combination is required by Applicants' claims. Therefore, Kashibuchi et al. fail to teach or suggest all of the limitations of the claimed invention. Since a *prima facie* case of obviousness has not been established, Applicants respectfully contend that this rejection should be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al. in view of McKay

Claims 14, 34 and 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. in view of McKay. Applicants respectfully traverse this rejection for two reasons. First, the combination of Yoshihara et al. and McKay does not establish a *prima facie* case of obviousness because it does not teach or suggest all of

Applicants' claim limitations. Second, even if a *prima facie* case was established, the obviousness argument is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

The combination of Yoshihara et al. and McKay does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Specifically, McKay does not teach or suggest a package having a plurality of openings through which a scalp cosmetic composition is applied directly to the scalp, as required by Applicants' claimed invention. McKay's fluid dispensing comb is designed to apply fluid to the hair, not the scalp (see Col. 3, lines 25-27 and 39-41).

Applicants' invention provides delivery of skin active agents to the scalp without unduly affecting hair cosmetics. The McKay comb would certainly affect hair cosmetics, since the hair shafts are the deposition point for McKay's fluid. McKay does not teach an applicator that applies fluid directly to the scalp. Yoshihara et al. do not teach an applicator of any kind. Therefore, the combination of Yoshihara et al. in view of McKay does not teach or suggest all of Applicants' claim limitations. Since a *prima facie* case of obviousness has not been established, Applicants respectfully contend that this rejection should be withdrawn.

Even if a *prima facie* case has been established, Applicants have overcome the presumption of obviousness by a showing of unexpected results. As discussed above, Yoshihara et al. do not suggest the surprising improvement in skin hydration demonstrated in the Declaration submitted by Applicants. Therefore, Applicants contend that their claimed scalp cosmetic composition is novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al. and McKay

in view of Kellett et al.


Claims 41-46 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. and McKay and further in view of Kellett et al. Applicants

respectfully traverse this rejection for the reasons laid out above regarding the combination of Yoshihara et al. and McKay. Specifically, the combination of references does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Also, even if a *prima facie* case was established, the obviousness argument is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that their claimed invention is novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

Conclusion

Applicants have made an earnest effort to distinguish their claimed invention from the applied prior art. WHEREFORE, reconsideration of this application, withdrawal of the rejections under 35 U.S.C. 103 and allowance of Claims 1-46 and 53-69 are respectfully requested.

Respectfully submitted,
Marjorie Mossman Peffly, et al.

By 
Brent M. Peebles
Attorney for Applicants
Registration No. 38,576
(513) 626-2404

May 23, 2001
Cincinnati, Ohio